

REMARKS

The Amendments

Claim 1 is amended to recite that the glass flakes have a layer thickness $\leq 1 \mu\text{m}$ and claims 5 and 6 are amended to more preferred embodiments; see, e.g., page 4, paragraph [0015], of the disclosure. Additional dependent claims analogous to existing claims are also added.

The Rejection under 35 U.S.C. §112, first paragraph

The rejection of claim 1 under 35 U.S.C. §112, first paragraph, is respectfully traversed. The rejection is based on the allegation that the claim reciting the proviso excluding a particular embodiment is not supported by the disclosure. Generally, under U.S. law, it is acceptable to add provisos limiting the scope of the claims without the need for any specific disclosure of the proviso; see, e.g., In re Johnson, 194 USPQ 187 (CCPA 1977). The basis for Johnson, which applies here, is that, since the whole scope of the original genus is clearly supported, a scope which only eliminates a small part of such scope must also be supported. In Johnson, the application described a genus encompassing a large number of species and described a number of specific species. Two of the specifically described species were excluded by proviso. Although there was no description at all in the specification that these two species should be excluded, it was held that the claim reciting the proviso was supported by the disclosure under 35 U.S.C. §112, first paragraph. The facts here are not substantially distinguishable. The genus is clearly supported by the disclosure, a very limited scope of species is excluded by the proviso and that limited scope of species is described in the specification (see page 3, lines 1-3). Although the "alternating layers of TiO_2 , SiO_2 and TiO_2 " embodiment is not specifically recited, it is clearly disclosed within the recitation of "glass flakes coated with one or more metal oxides, particularly of titanium, silicon ..." The following statement by the Court in Johnson fully applies here:

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and thus has failed to satisfy the requirement of §112, first paragraph, appears to result from a

hypertechnical application of legalistic prose relating to that provision of the statute.

For the reasons supporting the Johnson decision, the proviso recited in claim 1 is supported by the instant disclosure. Further, applicants disagree that Ex parte Parks is not applicable. Parks stands for the general proposition that support may be found even if literal support is lacking. Such general proposition clearly applies to the instant case. As in Parks, the currently claimed invention is supported, even though the proviso is not literally disclosed, because, under the reasoning of Johnson, the slightly limited scope due to the proviso was clearly conveyed to one of ordinary skill in the art in view of the broader scope of original claim 1. Thus, the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

The Obviousness-type Double Patenting Rejection

The obviousness-type double patenting rejection of claims 1-4 and 10-12 over the claims of U.S. Patent No. 6,517,628 (Pfaff) is respectfully traversed.

The arguments below made in traversal of the 35 U.S.C. §103 rejection over Pfaff are incorporated by reference herein. For those reasons, it is urged that the disclosure of Pfaff does not render the claimed invention obvious. Since the disclosure does not suggest applicants' invention, the Pfaff claims also could not suggest applicants' invention or be obvious variants thereof. Thus, the obviousness-type double patenting rejection should be withdrawn.

The Rejection under 35 U.S.C. §102 over Anselmann

The rejection of claim 1 under 35 U.S.C. §102, as being anticipated by Anselmann (WO 02/090488), is respectfully traversed.

Applicants maintain their position that a mere generic disclosure is insufficient basis to support an anticipation rejection. It is not relevant to the anticipation analysis whether applicants' claim is directed to a specific mixture. For anticipation, the reference must describe an embodiment within the scope of the claim in question. Anselmann fails to direct one of ordinary skill in the art to a specific embodiment of a pigment mixture containing a glass flake-based pigment and a flake-form, needle-shaped, spherical or crystalline colorant or filler,

according to applicants' claim 1. Anselmann merely generically discusses the option of mixing its glass flake-based pigments with other pigments (see, e.g., paragraph at pages 6-7), the reference does not direct one of ordinary skill in the art to any specific mixture, i.e., a specific one of the glass pigments with a specific one of the other pigments. Generic disclosures cannot form a basis for an anticipation rejection because such would preclude applicants from showing patentability of a selection invention within a genus.

At least for the above reasons, Anselmann does not anticipate the instant claims and the rejection under 35 U.S.C. §102 should be withdrawn.

The Rejection under 35 U.S.C. §102 over Ambrosius

The rejection of claims 1 and 11 under 35 U.S.C. §102, as being anticipated by Ambrosius (WO 03/006588), is respectfully traversed.

The arguments made above regarding Anselmann apply equally here and are incorporated by reference. The disclosure of Ambrosius in the paragraph bridging pages 14-15 does not describe any specific embodiment. Thus, it is a mere generic disclosure which does not support anticipation. The only specific embodiments of pigment mixtures in Ambrosius are not within the scope of applicants' claim 1 or 11.

At least for the above reasons, Ambrosius does not anticipate the instant claims and the rejection under 35 U.S.C. §102 should be withdrawn.

The Rejections of claim 11 under 35 U.S.C. §102

The rejections of claim 11 under 35 U.S.C. §102, as being anticipated by each of JP 2001-11340; Engelhard 2002, pages 2, 8, 10 and 14, and "SMOKES & SPARKLES" and "CHAMELEON" pages are respectfully traversed.

The cited references fail to disclose a pigment mixture according to the claims comprising an effect pigment based on glass flakes having a layer thickness $\leq 1 \mu\text{m}$ and an effect pigment of applicants' component B.

The Engelhard reference and the "SMOKES & SPARKLES" and "CHAMELEON" pages fail to disclose the layer thickness of the glass flakes therein.

The JP '340 reference discloses pigments based on glass flakes which are of greater layer thickness; see Examples 1-7. It also discloses in Example 8 a glass-based pigment having a layer thickness of 0.7 μm . However, there is only one pigment mixture example in JP '340 which contains the glass-based pigment of Example 8; see page 18 of the translation. The mixture example on page 18, however, does not appear to contain an effect pigment according to applicants' component B, i.e., an organic and inorganic flake-form, needle-shaped, spherical or crystalline colorant or filler. More particularly, it does not contain a component B effect pigment which is a pearlescent pigment, multilayered pigment or interference pigment; see, e.g., instant claim 2.

Accordingly, the references fail to anticipate a pigment mixture comprising an effect pigment based on glass flakes having a layer thickness $\leq 1 \mu\text{m}$ and an effect pigment of applicants' component B. Thus, the rejection under 35 U.S.C. §102 should be withdrawn.

The Rejections under 35 U.S.C. §103 over Anselmann and Ambrosius

The rejections of claims 2-10 under 35 U.S.C. §103, as being obvious over Anselmann or Ambrosius are respectfully traversed.

The discussion of Anselmann and Ambrosius from above is incorporated herein by reference. As pointed out above, these references provide a mere broad generic disclosure which may encompass the instant claims. Neither reference discloses an embodiment meeting all elements of the instant claims. Each reference provides a broad and unspecified disclosure regarding the combined use of filler or other pigments with the glass flake based pigments. There is no specific suggestion from either reference to provide a pigment mixture with the glass flake based pigment and an effect pigment according to applicants' component B, i.e., an organic and inorganic flake-form, needle-shaped, spherical or crystalline colorant or filler. More particularly, it does not contain a component B effect pigment which is a pearlescent pigment, multilayered pigment or interference pigment; see, e.g., instant claim 2. While the references' broad generic teachings may encompass use of such a pigment, a mere broad generic teaching does not necessarily support a finding of obviousness. As was clearly set forth in In re Jones, 21 USPQ 2d 1941 (Fed. Cir. 1992), it is not the law that "... regardless of how broad, a disclosure of

a chemical genus renders obvious any species which happens to fall within it." Instead, the disclosure must be considered as a whole as to whether it fairly suggests the claimed invention to one of ordinary skill in the art. See also In re Baird, 29 USPQ2d 1550 (Fed. Cir. 1994).

Applicants respectfully submit that there is no fair suggestion of the claimed invention from either reference. In the absence of such suggestion, the claimed invention is not rendered obvious and these rejections under 35 U.S.C. §103 should be withdrawn.

The Rejection under 35 U.S.C. §103 over Pfaff

The rejection of claims 1-13 under 35 U.S.C. §103, as being obvious over Pfaff (U.S. Patent No. 6,517,628) is respectfully traversed.

Pfaff provides a broad generic disclosure of pigments for its component A at col. 1, lines 38-44. The component A pigments disclosed for the mixture in Pfaff are generally disclosed as based on any of mica, SiO₂ flakes, glass flakes, Al₂O₃ flakes or polymer flakes. In the only specific embodiments disclosed in Pfaff, the component A pigment is based on mica or SiO₂; see Examples 1-7.

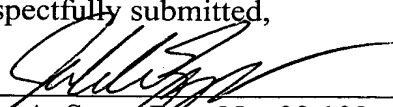
Pfaff fails to disclose an embodiment wherein a pigment mixture includes an effect pigment based on glass flakes. Further, the generic disclosure of Pfaff does not direct one of ordinary skill in the art to select pigments based on glass flakes and particularly glass flakes having a layer thickness $\leq 1 \mu\text{m}$. While Pfaff's broad generic teachings may encompass use of such a pigment, a mere broad generic teaching does not necessarily support a finding of obviousness. As was clearly set forth in In re Jones, 21 USPQ 2d 1941 (Fed. Cir. 1992), it is not the law that "... regardless of how broad, a disclosure of a chemical genus renders obvious any species which happens to fall within it." Instead, the disclosure must be considered as a whole as to whether it fairly suggests the claimed invention to one of ordinary skill in the art. See also In re Baird, 29 USPQ2d 1550 (Fed. Cir. 1994). Pfaff provides no direction to one of ordinary skill in the art to select a particular glass flake pigment having a particular layer thickness from among the many possible base materials for its component A pigments. Further, Pfaff, instead, directs one of ordinary skill in the art to select mica or SiO₂ based pigments for its component A. Thus, Pfaff fails to provide the requisite motivation directing one of ordinary skill in the art to

an embodiment according to applicants' claims. In the absence of such motivation, the 35 U.S.C. §103 rejection should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



John A. Sopp, Reg. No. 33,103
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-2867

Date: November 22, 2006

JAS:blb

K:\Merck\2000 - 2999\2867\REPLY 11-22-06.doc